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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,903	02/19/2002	Mohamed Bakry	BAKRY-I	4819

26009 7590 04/01/2004  
ROGER M. RATHBUN  
13 MARGARITA COURT  
HILTON HEAD ISLAND, SC 29926

EXAMINER

MCCROSKY, DAVID J

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/078,903

**Applicant(s)**

BAKRY, MOHAMED

**Examiner**

David J. McCrosky

**Art Unit**

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13, 16-23, 26-30 and 32 is/are rejected.
- 7) ☒ Claim(s) 10-12, 14, 15, 24, 25, 31 and 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 24-27 have been renumbered 22-25. Claims 21 and 23-25 are objected to because of the following informalities: it appears that claim 21 should depend from claim 20 and claims 23-25 should depend from claim 22; "member" in line 2 of claim 25 should read --members--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Held. Held discloses an outer tube (30) having a closed distal end and a central canal. An articulating member (46) extends through a peripheral opening at the distal end. An operative surface (48) faces the proximal end. The articulating member is extended using an inner movable member (42). See Figs. 1-4.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Agee et al. The reference discloses an outer tube (12) having a closed distal end (12B) and a central canal. An articulating member (14) extends through a peripheral opening

at the distal end. An operative surface faces the proximal end. The articulating member is extended using an inner movable member (16).

Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Rhum et al. The reference discloses an outer tube (11) having a closed distal end and a central canal. Articulating members (17) extend through peripheral openings at the distal end. The articulating members (17) have an operative surface facing the proximal end. See col. 6, ll. 46-50. The articulating members are extended using an inner movable member (19).

It has been held that the functional "whereby" statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957). The preamble has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Claims 27-29 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogirala. The reference discloses a method for a pleural biopsy needle. See col. 1, ll. 6-10. The method includes providing a needle with a closed distal end and an articulating member (9) extending from the distal end. A method of performing the biopsy is disclosed. See col. 4, ll. 12-47.

***Claim Rejections - 35 USC § 103***

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogirala in view of Alfranca. Ogirala discloses a pleural biopsy needle. See col. 1, ll. 6-10. The needle has a closed, pointed distal end and an articulating member (9) extending from a peripheral opening near the distal end. Ogirala does not teach actuating the articulating member using an inner movable member within an outer tube. However, Alfranca discloses a biopsy device having an outer tube and an inner member. The inner member, together with the handle at the proximal end, actuates the articulating member. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Ogirala with the inner movable member of Alfranca to facilitate actuation of the articulating member.

Claims 13, 16-23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhum et al in view of Marini. Rhum et al teach an outer tube (11) having a closed distal end and a central canal. Articulating members (17) extend through peripheral openings at the distal end. The articulating members (17) have an operative surface facing the proximal end. See col. 6, ll. 46-50. The articulating members are extended using an inner movable member (19). An outer tube cover (13) is located at the proximal end of the outer tube (11). The handle provides a stop means for the trigger. While disclosing several different embodiments for the articulating members (See Figs. 2-4), Rhum et al do not teach an end tube. Marini discloses a removable end tube (22) to allow usage of various end effectors. See Figs. 2-6. It would have been obvious to one of ordinary skill in the art at the time the invention was

made to modify the apparatus of Rhum et al with the end tube of Marini to allow usage of various end effectors.

Regarding claim 17, it would have been an obvious matter of design choice to modify Rhum et al and Marini by threadedly affixing the outer tube cover since Applicant has not disclosed that having a threaded attachment solves any stated problem or is for any particular purpose and it appears that the apparatus would perform equally well with an attachment of any type.

Regarding claim 18, it would have been an obvious matter of design choice to modify the outer tube cover with wings since Applicant has not disclosed that using wings solves any stated problem or is for any particular purpose and it appears that the apparatus would perform equally well with a means for gripping of any type.

Regarding claim 26, means for aspiration in a biopsy device is well-known in the art.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogirala as applied to claim 27 above. Ogirala discloses a method as recited for claim 27. The method accomplishes the same task as claimed but does not teach two articulating members. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a second articulating member, since it has been held that that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

***Allowable Subject Matter***

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Claims 10-12, 14, 15, 24, 25, 31 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. McCrosky whose telephone number is 703-305-1331. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mary Beth Jones can be reached on 703-308-3400. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJM

*Mary Beth Jones*  
*Acting SFC*  
*Art Unit 3736*